

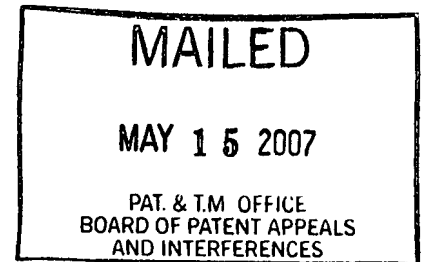
The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL H. HAUSER

Appeal 2007-0847
Application 09/472,762
Technology Center 2100



Decided: May 15, 2007

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-18.

THE INVENTION

The disclosed invention relates to the field of document management, and more particularly, to a system for providing document management for

the organization, handling, and retention of personal documents
(Specification 1).

Independent claim 1 is exemplary:

1. A computer-implemented method for adding a document to a plurality of stored documents, comprising:
 - loading the document into storage, said loaded document having a document category;
 - determining the document category of said loaded document;
 - extracting information from said loaded document indicating at least one of a document date, a document transaction type and a document identifier; and
 - applying to said loaded document at least one document handling procedure associated with the document category of said loaded document; said document handling procedure linking said loaded document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document.

THE REFERENCES

The Examiner relies upon the following references as evidence of anticipation and unpatentability:

MacPhail	US 5,107,419	Apr. 21, 1992
Unger	US 5,721,910	Feb. 24, 1998
Schmidt	US 6,418,457 B1	July 9, 2002

THE REJECTIONS

The following rejections are on appeal before us:

1. Claims 1, 3, 5, 9, 10, 13, and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Unger.

2. Claims 7, 11, 14, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Unger in view of the Examiner's taking of Official Notice.
3. Claims 2, 4, 6, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Unger in view of MacPhail.
4. Claims 12, 15, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Unger in view of Schmidt.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for the respective details thereof.

OPINION

Only those arguments actually made by Appellant have been considered in this decision. It is our view, after consideration of the record before us, that the evidence relied upon supports the Examiner's rejection of the claims on appeal. Accordingly, we affirm.

STATEMENT OF LAW (§ 102)

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*,

976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

Independent claims 1, 3, and 5

We consider first the Examiner’s rejection of claims 1, 3, and 5 as being anticipated by Unger.

Appellant acknowledges that Unger discloses the element of “determining the document category of the loaded document” at col. 3, ll. 9-15 (Br. 11, ¶ 2). Appellant further acknowledges that the language of claim 1 “does not dictate a temporal order on the determining and extracting steps” (Br. 12, ¶ 1, ll. 4-5). However, Appellant argues that the applying step must follow the determining and extracting steps because the applying step uses data generated from the determining and extracting steps (Br. 12, ¶ 1). Appellant further argues that Unger does not disclose the recited applying step (Br. 12). In particular, Appellant notes that the language of the claim requires applying a document handling procedure associated with the document category where the document handling procedure linking the document uses a document identifier [or document date or document transaction type] (Br. 15, ¶ 2, claim 1). Appellant concludes that the portion of Unger that discloses linking the patent number to one of the plurality of

stored patent documents (col. 6, ll. 48-51) does not teach the claimed document handling procedure (Br. 15, ¶ 2, claim 1).

The Examiner disagrees. The Examiner points out that Appellant's argument (i.e., that the applying step must use data generated from the determining and extracting step) is only true if the document does not already have a defined document category (Answer 9, ¶ 2). With respect to the claimed applying step, the Examiner argues that Unger discloses documents stored in the relational database (col. 3, ll. 22-25) that are linked to the categorization which reflects the overall hierarchical model, i.e., where the process of storing a document in the database is *inherently* a computer-implemented document handling procedure (col. 3, ll. 46-49, emphasis added) (Answer 12).

We begin our analysis by noting that our reviewing court has determined that “[u]nless the steps of a method actually recite an order, the steps are not ordinarily construed to require one.” *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1342-43, 59 USPQ2d 1401, 1416 (Fed. Cir. 2001), citing *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999) (stating that “not every process claim is limited to the performance of its steps in the order written.”). Here, we agree with the Examiner that the instant applying step does not depend upon the determining step so long as a loaded document already has a document category. We find that Unger's loaded documents (e.g., such as patents) inherently have associated categories when they are initially stored in Unger's database, even though specific document categories may not be identified or refined until later processing is

performed (e.g., see Unger, col. 3, ll. 9-15). Therefore, contrary to Appellant's arguments, we find the recited applying step merely depends upon the initial step of "loading the document into storage, said loaded document having a document category" (claim 1).

With respect to the applying step that applies a document handling procedure, we note that the Examiner, as finder of fact, has determined that process of storing a loaded document in Unger's database is *inherently* a computer-implemented document handling procedure (*see* Answer 12). We note that "[i]n relying upon the theory of inherency, the [E]xaminer must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). "[A]fter the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to [A]ppellant to 'prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.'" *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986) quoting *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971). *See also* MPEP §§ 2112 (IV.) and (V.).

In the instant case, we find that the Examiner has provided a compelling rationale in the Answer (*see* Answer 12). In particular, we agree with the Examiner that the process of storing a document in the database (or any other database document operation) is *inherently* a computer-implemented document handling procedure. As pointed out by the

Examiner, Unger discloses a database that uses categorization to identify trends and discontinuities:

The categorization may then be used by the relational database to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents and/or patents.
(col. 3, ll. 21-25).

Therefore, we find that the language of the claim (i.e., “applying to said loaded document at least one document handling procedure associated with the document category of said loaded document”) broadly but reasonably reads on Unger’s relational database operations in the manner asserted by the Examiner (Unger col. 3, ll. 21-25, instant claim 1). Furthermore, in reviewing the Briefs, we find that Appellant has not met the burden of proving that the subject matter shown to be in the prior art does not possess the inherent characteristic (i.e., the document handling procedure) relied on by the Examiner.

We further agree with the Examiner that the language of the claim (i.e., “said document handling procedure linking said loaded document to at least one of said plurality of stored documents using at least one of the document identifier extracted from said loaded document”) broadly but reasonably reads on Unger’s disclosure of: (1) linking documents stored in the relational database to other categorized documents (col. 3, ll. 46-49), and (2) using patent numbers as *unique identifiers* (i.e., document identifiers) to electronically link to full text sources of patents (i.e., at least one of said plurality of stored documents), as follows:

The *documents* and/or abstracts and/or claims and/or technical indexing may be *electronically stored in a relational database* and *linked* to the *categorization* which reflects the overall hierarchical model.
(col. 3, ll. 46-49, emphasis added).

The dashed line from Stage V to Stage I represents the fact that the data stored in the database, and all associated analyses of Stages II although VI, may be used to identify patents and/or technical documents of particular interest for a particular application. The patent numbers for this set of patents may then be used as *unique identifiers* to *electronically link to full text sources of patents* and display the full text and associated graphic images of the set of patents.
(col. 6, ll. 44-51, emphasis added).

Thus, we find that Unger discloses all that is claimed. Therefore, we will sustain the Examiner's rejection of representative claim 1 as being anticipated by Unger for essentially the same reasons argued by the Examiner in the Answer, and further discussed above.

With respect to independent claims 3 and 5, we note that Appellant essentially restates the same arguments previously presented for claim 1 (*see* Reply Br. 7-8). Therefore, we will sustain the Examiner's rejection of independent claims 3 and 5 as being anticipated by Unger for the same reasons discussed *supra* with respect to claim 1.

Dependent claims 9, 10, 13, and 16

We note that Appellant has not presented any substantive arguments directed separately to the patentability of dependent claims 9, 10, 13, and 16. In the absence of a separate argument with respect to the dependent

claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the Examiner's rejection of these claims as being anticipated by Unger for the same reasons discussed *supra* with respect to independent claims 1, 3, and 5.

STATEMENT OF LAW (§ 103)

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Independent claim 7

We consider next the Examiner's rejection of independent claim 7 as being unpatentable over Unger in view of the Examiner's taking of Official Notice.

We note that Appellant does not seasonably challenge the Examiner's taking of Office Notice. Instead, Appellant argues that Unger does not teach the applying step of claim 7 (Br. 20).

We note that the applying step (4) of claim 7 is essentially equivalent to the applying step recited in claim 1.¹ Because we have found *supra* that Unger teaches the applying step as claimed, we will sustain the Examiner's rejection of independent claim 7 as being unpatentable over Unger in view of the Examiner's taking of Official Notice.

Dependent claims 11, 14, and 17

We consider next the Examiner's rejection of dependent claim 11, 14, and 17 as being unpatentable over Unger in view of the Examiner's taking of Official Notice.

Appellant notes the Examiner took "Office Notice" in asserting that it would have been obvious to manually assign the document category when loading the document. Appellant argues that Unger teaches away from the manually assignment of the document category by the use of the expert technical searches which automatically categorize the documents in the

¹ We note that the recitation of "said plurality of personal documents" lacks antecedent basis in independent claim 7. Should prosecution be reopened,

Unger's database. Appellant points out that the Final Office Action fails to state the motivation or suggestion for altering the process in Unger from automatically categorizing the documents using expert technical searches versus manually assigning a category to each document. Thus, Appellant concludes that the Examiner has failed to establish a prima facie case of obviousness (Br. 20).

Contrary to the Examiner's findings, we note that the language of claims 11, 14, and 17 does not require *manually* assigning a category to each document. From our own independent review of the Unger reference, we find that Unger discloses an embodiment "wherein the document category is determined by a pre-determined category input with the loaded document," as claimed (claims 11, 14, and 17). For example, Unger discloses the computer system must have a pre-defined model (i.e., pre-determined category) of the overall scientific or business discipline and the computer system must have already analyzed the technical content of each patent or technical document with respect to that model:

In order to create a computer system which can answer higher level questions such as these, the computer system must have a *pre-defined model of the overall scientific or business discipline and the computer system must have already analyzed the technical content of each patent or technical document with respect to that model*. The system of sophisticated technical searches and the method of applying those searches to a set of technical documents, such as patents, *to categorize those documents* to match a multidimensional hierarchy which models a scientific or business entity or discipline is the subject of this patent memo.

we leave it to the Examiner to consider a 35 U.S.C. § 112 second paragraph rejection of independent claim 7 and associated dependent claims.

(col. 4, ll. 32-43, emphasis added).

Further, we find that Unger discloses an original classification (i.e., another type of predetermined category), as follows:

The relational database can also contain subject-specific tables of technical details such as catalyst precursors, cocatalysts, reaction conditions, reactor types, product characteristics, which are captured in a discrete form by scientists evaluating the underlying patents. The *original classification* serves to group similar patents together. *An individual scientist or engineer may then evaluate each patent in a particular group and capture the essential details of each invention into a subject-specific table which can be linked back to the original documents and/or abstracts and to the original categorization.* The expert analysis can also feed back into the *categorization* of the patents to *enhance the categorization* achievable by sophisticated technical searches.

(col. 4, ll. 44-57, emphasis added).

In view of the above discussion and our analysis of Unger's disclosure, it is our opinion that the Examiner's taking of "Official Notice" was unnecessary for a proper rejection of dependent claims 11, 14, and 17. As indicated *supra*, we find that all the elements of the claim are disclosed by Unger. We note that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for anticipation is the epitome of obviousness. *In re McDaniel*, 293 F.3d 1379, 1385-1386, 63 USPQ2d 1462, 1466 (Fed. Cir. 2002); *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). *See also In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Therefore, because anticipation is

the epitome of obviousness, we will sustain the Examiner's rejection of dependent claims 11, 14, and 17 as being unpatentable over Unger alone.

Dependent claims 2, 4, 6, and 8

We consider next the Examiner's rejection of dependent claims 2, 4, 6, and 8 as being unpatentable over Unger in view of MacPhail.

Appellant notes the Examiner relies on MacPhail for teaching that the processing rule includes retention criteria for determining how long to save a document. Appellant argues that MacPhail is not properly combinable with Unger because Unger appears to teach away from establishing any sort of retention scheme for the records in the technical database. As support, Appellant points to col. 6, ll. 24-33 of Unger:

The database system allows patents and/or technical documents to be electronically captured and analyzed at a convenient time. This set of analyzed patents and/or technical documents may then be used to identify trends and discontinuities in the overall pattern of research efforts represented by the set of patents or technical documents. These trends and discontinuities may be identified any time following the analysis of the set of patents and/or technical documents. The stored analysis may be used minutes, days, months or years later.
(col. 6, ll. 24-33).

The Examiner responds that management of a database (such as Unger's relational database) is always needed. The Examiner argues that although Unger teaches a database system that enables patents and/or technical documents to be electronically captured at any time, the fact that the stored analysis may be used minutes, days, months, or even years later

does not preclude the need to manage the document database (i.e., the need to develop retention criteria for stored documents) (Answer 14).

With respect to Appellant's argument that Unger "teaches away" from MacPhail, we note that Unger and MacPhail are each broadly directed to the various aspects of document management, as is the instant invention. Therefore, we find the cited references are analogous by virtue of being from the same field of endeavor as the instant invention. *See In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) ("The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.") (internal citation omitted).

While we agree with Appellant that technical documents such as patents may have an extended life in terms of relevancy to current technological trends, we nevertheless find the weight of the evidence supports the Examiner's position that the well-known use of a document retention scheme (such as taught by MacPhail) would have provided a utility that would have reasonably motivated an artisan to combine Unger and MacPhail in the manner suggested by the Examiner, especially if database storage capacity is limited. Obviously, a patent database with over six million patents would contain many technologically obsolete patents that have little or no relevancy to current technologies. Furthermore, we agree with the Examiner that a database that includes documents that are not needed (e.g., because the user is only interested in a specific category of technology) would benefit from some form of document management

scheme, such as the document retention method taught by MacPhail (*see* MacPhail, Abstract). Therefore, for at least the aforementioned reasons, we find the preponderance of the evidence supports the Examiner's position. Accordingly, we will sustain the Examiner's rejection of dependent claims 2, 4, 6, and 8 as being unpatentable over Unger in view of MacPhail.

Dependent claims 12, 15, and 18

Lastly we consider the Examiner's rejection of dependent claims 12, 15, and 18 as being unpatentable over Unger in view of Schmidt.

Appellant argues that the documents in Unger's database (e.g., patents and/or technical documents) are unsuitable for the document handling methods taught by Schmidt. Appellant further argues that Unger's technical documents have a fixed context (e.g. a patent document), and, in contrast, Schmidt's documents may undergo revisions (Br. 24). Therefore, Appellant concludes that an account number or transaction date (such as taught by Schmidt) would have little utility in Unger's database system (Br. 24-25).

We disagree. When we take account of the inferences and creative steps that a person of ordinary skill in the art would employ, we find it reasonable that an artisan would have been motivated to add user account numbers and user transaction dates to Unger's database system to track database access by user and date, as well as to track history (i.e., patent history) in the manner suggested by the Examiner in the Answer (*see* Answer 15-16). Therefore, we do not find Appellant's argument persuasive, and we find that Appellant has not shown error in the Examiner's *prima facie* case of obviousness. Accordingly, we will sustain the Examiner's

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rejection of dependent claims 12, 15, and 18 as being unpatentable over Unger in view of Schmidt.

DECISION

In summary, we have sustained the Examiner's rejection of all claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

PGC

Cascadia Intellectual Property
500 Union Street
Suite 1005
Seattle, WA 98101